

**REMARKS**

This paper is filed in response to the final Office Action mailed on May 4, 2005. Claims 4-7 have been allowed and claims 9-10 have been objected to but indicated as including allowable subject matter. In response, claim 1 has been amended to traverse all prior art rejections and render claims 2-3, 8 and 11-20 allowable over the prior art of record.

Applicants respectfully submit that this amendment is in full compliance with Rule 116 because it raises no new issues, narrows the pending claims, traverses all prior art rejections and places the application in a condition for allowance. An early action entering this amendment is earnestly solicited.

Turning to the rejections based upon the prior art, the Office Action rejects claims 1, 3, 8 and 11-20 under 35 U.S.C. §102(b) as allegedly being anticipated by European Patent 1 164 434 ("Nishimura"). In response, Applicants present the following remarks.

At the outset, under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Citing, Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In response to the maintenance of the anticipation rejection based upon Nishimura, Applicants have amended claim 1 to replace the transitional phrase "comprising" with "consisting essentially of" which clearly differentiates the polymers of Nishimura from amended claim 1. Amended claim 1 now requires the photoresist polymer to consist essentially of the repeating unit of the polycyclic monomer moiety (unit a) and a single carbon moiety having an ester group (units b and c) as the main chain. In short, the photoresist polymer of amended claim 1 excludes a situation where one of the monomer moieties includes a methyl group off of the main chain as indicated in Formula III-1 of Nishimura. With no methyl groups disposed on the main chain, amended claim 1 is no longer anticipated by Nishimura.

The single carbon moiety of amended claim 1 is obtained by reacting maleic anhydride with an alcohol or alkoxide compound and a ring-opening maleic anhydride, then a esterifying or acetylating the carboxyl group, which produces by the reaction of allowed claim 4.

In contrast, the acid-labile group-containing resin of Nishimura comprises repeated units of formulas I-1, which comprises a polycyclic group, and III-1 which comprises a methacrylate group unit as the main chain. See page 51, example 22 and page 54 which was relied upon by the Patent Office in rejecting claim 1. Nishimura does not disclose a photoresist polymer that comprises a single carbon moiety having an ester group such as units b or c of amended claim 1.

Therefore, amended claim 1 is clearly not anticipated by Nishimura and the anticipation rejection of claims 1, 3, 8 and 11-20 is respectfully traversed.

Next, the Office Action rejects claim 2 under 35 U.S.C. §103 as being unpatentable over Nishimura. However, in view of the restrictive amendment to claim 1, Applicants respectfully submit that this rejection is improper under MPEP §§ 2142 and 2143, which require:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

*Citing, In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Nishimura cannot serve as an obviating reference for claim 2 because of its failure to teach or suggest all of the claim limitations of claim 1, from which claim 2 depends. Specifically, Nishimura fails entirely to teach or suggest the polymer of Formula 1 for the reasons set forth above and therefore not all of the limitations of claim 1 are taught or suggested by Nishimura. Accordingly, Nishimura fails to establish a *prima facie* case of obviousness for claim 1 and therefore Applicants respectfully submit that the rejection of claim 2 under 35 U.S.C. §103 as being unpatentable over Nishimura is improper and should be withdrawn.

An early action indicating the allowability of claims 1-20 is respectfully requested.

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Respectfully submitted,

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